



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/535,378

06/29/2006

Mark H Kaplan

50425/223

1608

1912

7590

07/21/2009

AMSTER, ROTHSTEIN & EBENSTEIN LLP  
90 PARK AVENUE  
NEW YORK, NY 10016

EXAMINER

CHUNDURU, SURYAPRABHA

ART UNIT

PAPER NUMBER

1637

MAIL DATE

DELIVERY MODE

07/21/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/535,378	<b>Applicant(s)</b> KAPLAN, MARK H	
	<b>Examiner</b> Suryaprabha Chunduru	<b>Art Unit</b> 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,13,16,19,20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,16 and 20 is/are allowed.
- 6) ☒ Claim(s) 13, 19, 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. The Applicants' response to the office action field on April 24, 2009 has been considered and acknowledged.

***Status of the Application***

2. Claims 1-2, 13, 16, 19-20, 22 are pending under examination. Claims 24-27, 34-35, 72, 119-123 were cancelled by the amendment. All arguments and amendment have been fully considered and deemed persuasive in-part for the reasons that follow. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The action is made FINAL.

***Response to arguments:***

3. With regard to the telephonic interview on February 05, 2009, Applicants' response was fully considered. However, Examiner notes that a brief interview was conducted and Examiner suggested incorporation of 'consisting of' language, the suggestions are reflected in the claim 1 as presented now.

4. With regard to the rejection of claims 1-2, 13, 16, 19-20, 34-35, 72, 119-123 under 35 USC 102(b) as being anticipated by Chang et al. Applicants' arguments and amendment reciting 'consisting of' were fully considered and the rejection is withdrawn herein in view of the amendment.

4. With regard to the rejection of claim 41 under 35 USC 103(a) as being unpatentable over Chang et al. in view of Lowe et al., Applicants' arguments and the amendment were fully considered and found persuasive in view of the amendment cancelling the claim.

5. With regard to the rejection of claims 13, 19, 22, 24-27, 41, 72, 119-123 under 35 USC 112, first paragraph, Applicants' arguments and the amendment were fully considered and found

persuasive in-part in view of the amendment. The rejection is moot with regard to claims 24-27, 41, 72, 119-123 in view of the cancellation of these claims. With regard to the rejection of claims 13, 19, 22, Applicants argue that the claims are amended to recite 'contiguous portion' and therefore the rejection should be withdrawn. The arguments and the amendment were found unpersuasive. Examiner notes that the instant specification does not define 'contiguous portion' and the claims 13, 19, 22, as amended recite 'a contiguous portion thereof' do read on fragments or variants including by permutations and combinations deletions, substitutions or insertions, for which the instant specification lacks support. In addition, contiguous portion could include a stretch of two or more nucleotide sequences and the fragments resulting from such contiguous portions of the claims lack written support in the specification since the specification lacks support for the minimum or maximum length of the contiguous portion. Therefore the rejection is maintained for claims 13, 19, 22.

### ***Conclusion***

Claims 1, 2, 16, and 20 are allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Suryaprabha Chunduru/

Primary Examiner, Art Unit 1637